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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|----------------------------|
| 10/797,303 | 03/09/2004 | Gary Weller | 514362001410 | 4452 |
| 7590 | 07/10/2008 | | | |
| John S. Nagy (Fulwider, Patton , Lee & Utecht, LLP) Howard Hughes Center 6060 Center Drive, Tenth Floor Los Angeles, CA 90045 | | | | EXAMINER YABUT, DIANE D |
| | | ART UNIT 3734 | | PAPER NUMBER |
| | | | MAIL DATE 07/10/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/797,303 | WELLER ET AL. | |
| | Examiner | Art Unit | |
| | DIANE YABUT | 3734 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 February 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-11 and 13-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-11 and 13-28s is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

This action is in response to applicant's amendment received on 02/20/2008.

The examiner acknowledges the amendments made to the claims.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3-11, and 13-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Deem** (U.S. Pat. No. **6,558,400**) in view of **Schurr** (U.S. Pub. No. **20020082621**).

Claims 1, 3-11, 17, 21 and 26: Deem discloses a rectangular or arcuate distal working portion having a longitudinal axis, a perimeter, and an inner volume or vacuum chamber adapted to adhere tissue thereto, the working portion comprising a first acquisition member and a second acquisition member in apposition to one another along a first longitudinal axis, having an elongate body parallel and attachable to the first and second acquisition members, wherein each of the acquisition members are adapted to adhere tissue thereto such that the tissue is positioned between the first and second acquisition members or within the inner volume and about the perimeter of the distal working portion to define a gastric pouch, and at least one of the acquisition members being movable relative to the first longitudinal axis between a delivery

configuration and a deployment configuration, the device also comprising a septum removable positioned between the first and second acquisition members (Figures 9A-11B, col. 10, lines 39-65, col. 11, line 3 to col. 12, line 33).

Deem discloses the claimed device, including a tissue acquisition member being a vacuum chamber, except for the tissue acquisition member being movable relative to the longitudinal axis between a delivery configuration and a deployment configuration, or being pivotally movable relative to the septum.

Schurr teaches a tissue acquisition member **200** being pivotally movable relative to a septum **110** (Figures 4-5). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a pivotable tissue acquisition member, as taught by Schurr, to Deem since it was known in the art that pivotable tissue acquisition members facilitates grasping and apposition of tissue to ensure a secure engagement of the tissue(s).

Claims 13-15 and 22-24: Deem discloses an expandable element **52** being selected from the group consisting of a scope, a balloon, and a wire form, and the device being adapted for use with an endoscope (Figures 3A-3C and 17A, col. 8, lines 31-39, col. 15, lines 40-44).

Claims 16 and 25: Deem discloses the claimed device except for the device comprising a transducer. However, Deem does disclose a vacuum (see paragraph 6 above) and it was well known in the art to use a transducer with a vacuum in order to tell the pressure at the anvil portion prior to stapling the tissue, and therefore it would have been obvious to one of ordinary skill.

Claims 18-19 and 27-28: Deem discloses the claimed device except for the septum being made of a bioabsorbable material selected from the group consisting of polylactic acid (PLA), poly(lactic-co-glycolic acid) (PLGA), and polyglycolic acid (PGA). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a septum made of bioabsorbable.

Claim 20: Deem discloses the tissue acquisition member comprising a cartridge assembly containing at least one fastener **160** therein for affixing to tissue (Figures 8A-8B).

Response to Arguments

3. Applicant's arguments filed 02/20/2008 have been fully considered but they are not persuasive.
4. The applicant generally argues that the combination of Deem and Schurr would not have been obvious and that Schurr does not disclose an acquisition member being movable relative to the longitudinal axis of first and second acquisition members, and instead Schurr teaches an acquisition member 200 moving relative to an axis transverse to the longitudinal axis of the acquisition member. However, the acquisition member 200 of Schurr does move relative to the longitudinal axis of the acquisition member 110, as seen by the arrows in Figure 5. The examiner also maintains that the combined teachings of Deem and Schurr suggest to those of ordinary skill in the art that having a pivotable tissue acquisition members would further facilitate grasping and apposition of tissue to ensure a secure engagement of the tissue(s). The modification

would have been obvious because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIANE YABUT whose telephone number is (571)272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Diane Yabut/
Examiner, Art Unit 3734

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3731